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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,623	07/07/2007	John Anthony Downes	102965-010100	1812
33717 7590 12/02/2009 GREENBERG TRAURIG LLP (L.A.) 2450 COLORADO AVENUE, SUITE 400E INTELLECTUAL PROPERTY DEPARTMENT SANTA MONICA, CA 90404				
EXAMINER				
MEYER, JACOB B				
ART UNIT		PAPER NUMBER		
3618				
NOTIFICATION DATE		DELIVERY MODE		
12/02/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/599,623

**Applicant(s)**

DOWNES, JOHN ANTHONY

**Examiner**

JACOB MEYER

**Art Unit**

3618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-10 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10, 12, 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Newly submitted claim 13 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 13 recites the panel being formed by a plurality of vertical baffles, the plurality of vertical baffles being extruded and having a plurality of spacers provided between the baffles, the spacers being supported by elongate horizontal shafts. The originally presented invention does not require these limitations. The inventions require a different field of search due to a requirement for employing dissimilar search queries directed to the distinct features (as discussed above) of the two species. Additionally, it is noted that the claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 13 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6-10, 12 and 14 are rejected under 35 U.S.C. 103(a) as obvious over Downes (UK Pat. No. 2,229,689) in view of Metcalf (US Pat. No. 5,257,822).

Regarding claim 1, Downes discloses a device (Figure 1) for preventing spray from emerging from a wheel of a vehicle (Abstract), the device comprising a generally planar panel (the entire device disclosed in Figures 1-3, comprising Elements 4-10) that is adapted to be mounted substantially vertically behind a vehicle wheel (Figure 1) for receiving on a first side (location of Element 4 in Figure 1) water released by the wheel as it rotates (page 2, paragraphs 2-4), the panel including at least one passage (Element 6) which leads from the first side to a rear second side of the panel (Figure 3), the at least one passage being other than normal to the plane of the panel (as seen from Figure 3), and at least one water-collecting pocket (Element 7) along the side of the at least one passage, wherein, in use, air and water entering the at least one passage are separated so that air passes through the at least one passage and mixes with ambient air on a second side of the panel, and water collects in the at least one water-collecting pocket (see at least paragraphs 2-3 of page 2). For further detail please see the remaining figures and specification. Downes discloses a generally planar panel (see above) that extends partially around a road wheel. Additionally, Metcalf discloses a generally planar (Figure 1, Element 1) spray prevention device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the technique of employing a generally planar configuration of Metcalf (and others as previously cited in the conclusion of the previous Office action) with the structure as disclosed in Downes, since it was well-known in the art to provide spray guards that are generally planar, since this arrangement would allow for the spray guard to be easily replaced during maintenance. Therefore, the above combination is no more than the

simple substitution of a known technique to a piece of prior art ready for improvement yielding the predictable results of a device better suited for quick and easy maintenance.

Regarding claim 2, Downes in view of Metcalf discloses the invention wherein the panel is formed from a plurality of vertical baffles (at least shown at Elements 4, 5 of Figure 3) positioned in a side by side relationship with passages therebetween (also see page 2, paragraph 4).

Regarding claim 3, Downes in view of Metcalf discloses the invention wherein the plurality of vertical baffles are substantially identical in shape (Figure 3, and page 2 at least at paragraph 4).

Regarding claim 4, Downes in view of Metcalf discloses the invention wherein the plurality of vertical baffles overlap one another (at least at Figure 3, and page 2 paragraph 4).

Regarding claim 6, Downes in view of Metcalf discloses the invention wherein the at least one passage is non-linear (at least at Figure 3, and page 2 paragraph 4).

Regarding claim 7, Downes in view of Metcalf discloses the invention wherein the water-collecting pockets are arranged so as to collect water following a change of direction in the at least one passage (at least at Figure 3, and page 2 paragraph 4). It is noted that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

Regarding claim 8, Downes in view of Metcalf discloses the invention wherein the at least one passage has two changes of direction (at least at Figure 3, and page 2 paragraph 4).

Regarding claim 9, Downes in view of Metcalf discloses the invention wherein the at least one pocket is a channel running substantially vertically along a respective baffle, so that, in use, water drains from the baffles onto a surface on which the wheel is traveling (at least at Figure 3, and page 2 paragraph 4).

Regarding claim 10, Downes in view of Metcalf discloses the invention wherein the channel is substantially U-shaped (at least at Figure 3, and page 2 paragraph 4).

Regarding claim 12, Downes in view of Metcalf discloses the invention wherein the baffles overlap one another (at least at Figure 3, and page 2 paragraph 4).

Regarding claim 14, Downes in view of Metcalf discloses the invention as discussed above with respect to claim 1. It is noted that under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. Additionally, it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not amount to the mere claiming of a use of a particular structure.

#### ***Response to Arguments***

4. Applicant's arguments filed 08/12/2009 have been fully considered but they are not persuasive. Pertaining to the limitation, "generally planar," it is noted that this phrase is broad in scope, and does not define the invention in a way that overcomes the disclosure of the prior art

(see at least Figure 1 of Downes and Metcalf). In response to applicant's argument that Downes and Metcalf do not address the specific air flow characteristics and resulting spray formation, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

### *Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The documents cited in the Notice of References Cited attached hereto and in the Office action mailed 04/13/2009 disclose numerous aspects of the claimed invention and may be of interest to Applicant.

6. Applicant's amendment necessitated the new ground(s) of rejection (if any) presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JACOB MEYER whose telephone number is (571)270-3535. The examiner can normally be reached on Monday - Thursday 9am to 7pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, PAUL N. DICKSON can be reached on 571-272-7742. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. M./  
Examiner, Art Unit 3618

/LESLEY D MORRIS/  
Supervisory Patent Examiner, Art Unit 3611